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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 059643.00559 |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____ | Application Number: 10/518,365 | Filed: January 31, 2005 |
| | First Named Inventor: Jan KALL | |
| | Art Unit: 2617 | |
| | Examiner: N.H. LY | |

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

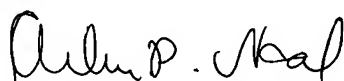
This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.
Registration No. 43,828
- ☐ Attorney or agent acting under 37 CFR 1.34.
Reg. No. is acting under 37 CFR 1.34 _____


Signature

Arlene P. Neal
Typed or printed name

703-720-7897
Telephone number

October 22, 2007
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jan KALL et al.

Application No.: 10/518,365

Filed: January 31, 2005

For: PROVIDING LOCATION INFORMATION OF A USER EQUIPMENT

Confirmation No.: 8234

Art Unit: 2617

Examiner: N.H. LY

Attorney Dkt. No.: 059643.00559

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

October 22, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 18-35 in the above identified application. Claims 18-35 were finally rejected in the Office Action dated June 21, 2007. Applicants filed a Response to the Final Office Action on September 21, 2007, and the Office issued an Advisory Action dated October 10, 2007 maintaining the final rejections of claims 18-35. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review. A Notice of Appeal is filed timely concurrently herewith. This Pre-Appeal Brief Request for Review is being timely filed. As will be discussed below, numerous clear errors exist in the final rejections that require withdrawal thereof.

Claims 18, 21, 26-29 and 32-35 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,708,033 to Linkola (hereinafter Linkola) in view of U.S. Patent No. 5,924,027 to Valentine (hereinafter Valentine) and U.S. Patent Publication No. 2003/0157942 to Osmo (hereinafter Osmo). Claims 22, 23, 24 and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Linkola in view of Valentine and Osmo and further in view of Official Notice. The Office Action took the position that Linkola, Valentine and Osmo teach each and every element recited in claims 22, 23, 24 and 25, except for storing the connection information in a radio network controller of the communication system or in a mobile switching center of the communication system or in a GPRS support node of the communication system or in a serving mobile location center of the communication system. However, the Office Action alleged that storing the connection information in a radio network controller of the communication system or in a mobile switching center of the communication system or in a GPRS support node of the communication system or in a serving mobile location center of the communication system are known in the art. Therefore, according to the Office Action, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of

Linkola, Valentine and Osmo to provide the method as claimed. As outlined below, Linkola, Valentine and Osmo fail to disclose or suggest each of elements of claims 18, 21, 26-29 and 32-35. The failure of Linkola, Valentine and Osmo to disclose each and every element of the present claims constitutes clear error.

Linkola teaches a system for changing the service profile of a mobile subscriber including a location part, an evaluation part, and a subscriber connection exchange part. A home location register contains individual subscriber connections, which have a different service profiles. The location part finds out the location of the mobile station in the network and to give location information to the evaluation part, which checks if the location information has changed compared with the location information received earlier. If the information has changed, it searches the memory for the corresponding location information and compares the connection information in the record with the current connection information. If the connection information is identical, the process remains waiting for new location information. If the connection information is different, the evaluation logic deduces that the connection must be exchanged for a new one and a connection exchange operation must be started.

Valentine discloses an improved cellular communications system and method which routes incoming calls to those subscribers who do not answer their page. The incoming call is routed to one of a list of alternate numbers, such as a home or work number in a public telephone system. Based upon the last known location of the subscriber within the cellular system, a particular list of such alternate numbers is tried in an effort to contact the subscriber outside the cellular network. Different lists are utilized depending upon the subscriber's last known location. In a first embodiment of the present invention, the various lists are stored in a home location register for the cellular system which forwards a particular list to the mobile switching center servicing the subscriber. In a second embodiment of the present invention, the particular list is stored within and forwarded by a service control point within an intelligent network

Osmo discloses a method of providing location dependent information in a communications system. See at least the Abstract of Osmo.

Applicant submits that the rejection of claims 18, 21, 26-29 and 32-35 under 35 U.S.C. 103(a) based on the teachings of Linkola, Valentine and Osmo is clearly erroneous. Applicants submit that the combination of Linkola, Valentine and Osmo fails to teach or suggest each element of the presently pending claims. Each of claims 18, 29 and 35, in part, recites determining whether the user equipment is currently unreachable in the network, wherein if the user equipment is currently unreachable in the network, the location of the user equipment is determined in dependence on the last stored connection

information for the user equipment. As acknowledged in the Office Action, Linkola does not teach or suggest this feature.

As noted above, Linkola discloses a system for changing a "service profile" of a mobile subscriber. A service profile is a record of the services that a subscriber has chosen to pay for and can be provided by the operator of the system. See Col. 3, line 63 to Col. 4, line 7. The system in Linkola allows the service profile to be changed automatically, depending on the location of the subscriber. See Col. 5, line 41-45. The system in Linkola includes a location part that provides location information on the mobile station, an evaluation part that determines if the location has changed compared to earlier information, and a connection exchange part that updates the service profile.

The Office Action alleged that it would be obvious to modify Linkola to include the feature of determining whether the user equipment is currently unreachable in the network, wherein if the user equipment is currently unreachable in the network, the location of the user equipment is determined in dependence on the last stored connection information for the user equipment, as recited in the pending claims. Specifically, the Office Action alleged that it would have been obvious to include the features from Valentine "in order to improve cellular communications system and method".

However, Applicants submit that there would be no technical reason to modify the system of Linkola to include the determining feature recited in the present claims. As previously noted, Linkola is only concerned with updating the service profile for a user. If a user in Linkola is unreachable in the network, then the user is inherently unable to make use of any services. If the user cannot make use of any services, then the service profile for the user is redundant. Therefore, the system disclosed in Linkola would not use or care about the last stored connection information if the mobile station is unreachable. There are no circumstances in which the system in Linkola would use location information in the case that the mobile station is unreachable in the network. This is particularly the case because the system in Linkola is implemented on the subscriber identity module (SIM) installed in the mobile station itself. See Col. 6, line 52-55 of Linkola. Therefore, if the mobile station is unreachable, it would be unable to communicate with the network and the system of Linkola would not operate at all.

Applicants therefore submit that neither Linkola nor Valentine provides any teaching, suggestion or motivation for the inclusion of the determining feature. One skilled in the art would readily appreciate the technical reasons why the determining feature of the presently pending claims would not make sense for the system in Linkola. Hence, the Applicants submit that one skilled in the art would not combine the teachings of Linkola and Valentine.

Each of the pending claims also recites, in part, translating the connection information into geographical coordinates. There is no reason why one skilled in the art would incorporate translating the

connection information into geographical coordinates in the system of Linkola. As stated above, the system of Linkola is only concerned with the updating of service profiles based on location. The service profiles relate to the services available in the mobile communication system. Therefore, the locations of interest to Linkola are locations in the network itself. See Col. 5, line 30-32. The network location information is sufficient for Linkola, and there is no advantage in translating this into geographical coordinates. Hence, there is also no teaching, suggestion or motivation to include translating the connection information into geographical coordinates in Linkola. Therefore, it would not be obvious for one skilled in the art to combine Linkola and Osmo in an effort to translate the connection information into geographical coordinates in the system of Linkola.

Furthermore, Applicants submit that the Office Action has provided no proof that connection information, as recited in claims 22, 23, 24 and 25, is known to those skilled in the art. Specifically, the Office Action has provided no evidence that connection information including a service area identity or a cell global identity, as recited in claim 18, is known to one skilled in the art to be stored in a radio network controller of the communication system or in a mobile switching center of the communication system or in a GPRS support node of the communication system or in a serving mobile location center of the communication system. Thus, Applicants traverse the Official Notice taken in the Office Action that it is known to those skilled in the art that connection information is to be stored in a radio network controller of the communication system or in a mobile switching center of the communication system or in a GPRS support node of the communication system or in a serving mobile location center of the communication system, as recited in claims 22, 23, 24 and 25. This taking of Official Notice is further evidence of clear error in the rejection. Based on the distinctions noted above, Applicants respectfully asserts that the rejection under 35 U.S.C. 103(a) is clearly erroneous request and should be withdrawn because neither Linkola, Valentine nor Osmo, whether taken singly or combined, teaches or suggest the combination of features recited in claims 18, 29 and 35, and hence dependent claims 21, 26-28 and 32-34 thereon.

Claims 19, 20, 30 and 31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Linkola in view of Valentine and Osmo and further in view of U.S. Patent No. 6,603,976 to Amirijoo (hereinafter Amirijoo). The Office Action took the position that Linkola, Valentine and Osmo teach each and every element recited in claims 19, 20, 30, and 31, except for the location service being provided by a gateway mobile location center. However, the Office Action combined the teachings of Linkola, Valentine, Osmo and Amirijoo as teaching this feature, and as such, the Office Action concluded that it would have been obvious to one of ordinary skill in the art to have combined the teaching of the references to generate claims 19, 20, 30, and 31. As outlined below, Linkola, Valentine,

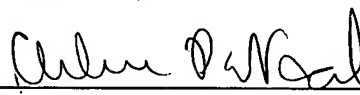
Osmo and Amirijoo fail to disclose or suggest each of elements of claims 18 and 29, upon which claims 19, 20, 30, and 31 depend. The failure of Linkola, Valentine, Osmo and Amirijoo to disclose each and every element of the present claims constitutes clear error.

Linkola, Valentine and Osmo are discussed above. Amirijoo teaches a wireless communications system capable of delivering Time Of Arrival (TOA) positioning data to at least one externally operated and maintained requesting agent, including a gateway to the external agent, which provides an interface to the requesting agent.

Amirijoo does not cure the deficiencies of Linkola, Valentine and Osmo, as outline above. Specifically, Amirijoo fails to teach or suggest why one skilled in the art would modify Linkola to determine whether the user equipment is currently unreachable in the network, wherein if the user equipment is currently unreachable in the network, the location of the user equipment is determined in dependence on the last stored connection information for the user equipment, as recited in claims 18 and 29, upon which claims 19, 20, 30, and 31 depend. Therefore, Applicants respectfully submit that the rejection under 35 U.S.C. 103(a) is in clear error and should be withdrawn because neither Linkola, Valentine, Osmo nor Amirijoo, whether taken singly or combined, teaches or suggest the combination of features recited in claims 18 and 29, and hence dependent claims 19, 20, 30, and 31 thereon.

For all of the above noted reasons, it is strongly submitted that certain clear differences exist between the present invention as claimed in claims 18-35 and the prior art relied upon by the Examiner. It is further submitted that these differences are more than sufficient that the present invention would not have been anticipated or obvious to a person having ordinary skill in the art at the time the invention was made. This final rejection being in clear error, therefore, it is respectfully requested that the Examiner's decision be reversed in this case regarding the rejections of claims 18-35, and indicate the allowability of all of pending claims 18-35. Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
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